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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,373

03/31/2004

Andrew L. Oleson

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04/12/2006

ROGER H. STEIN

Wallenstein Wagner & Rockey, Ltd.

311 S. WACKER DRIVE

53RD FLOOR

CHICAGO, IL 60606-6630

EXAMINER

FERGUSON, MARISSA L

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/814,373

Applicant(s)

OLESON, ANDREW L.

Examiner

Marissa L. Ferguson-Samreth

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51, 52 and 59-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51, 52 and 71-80 is/are allowed.
- 6) ☒ Claim(s) 59-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59,60,63-66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Rivin (2003/0185624) in view of Deschenes (US Publication 2002/0148172).

Regarding claims 59 and 65 Rivin teaches a method and apparatus comprising a set of uniform thickness (Page 2, Paragraph 0024, Lines 13-15) elastomeric shims (elements 12,13) and wherein each shim of each set adapted to be optionally positioned between a frame holder and the frame (Figure 2) such that the shims of a set can be used simultaneously with all of the frame holders in a number of different combinations to adjust and evenly increase the vertical distance between the frame and the item to be printed upon (this limitation is not positively claimed and the set of shims in the prior art has the capability of being simultaneously used in different combinations). However, Rivin does not teach a plurality of shims of different thicknesses.

Deschenes teaches a package/bundle of shims (18,28) with different thicknesses (Abstract and Page 2, Paragraph 0031). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as

taught by Rivin to have a plurality of shims of different thicknesses as taught by Deschenes, since Deschenes teaches that it is advantageous to have selectable thicknesses to provide an easier method of properly aligning shims.

Regarding claims 60 and 66, Rivin teaches a method and apparatus claimed with the exception of wherein each shim has a means associated therewith for interconnecting the shim to another shim and/or to a frame holder such as a contact area. Deschenes teaches a thin strip of wood (element 15 can function as the means for interconnection) that joins the surfaces of both shims together (Abstract and Paragraph 0032) and uses an adhesive tape (30) for holding shim assemblies of one row to another row during shipping. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Rivin to have an interconnection means as taught by Deschenes, since Deschenes teaches that it is advantageous to properly and effectively join the shims together in a secure manner.

Regarding claims 63,64 and 69, Rivin teaches a method and apparatus claimed with the exception of each set of shims or one or more sets having one or more shims and the first predetermined thickness can be the same or different than the second predetermined thickness. Deschenes teaches a bundle/package of shims (18,28) having different predetermined thicknesses (Abstract and Page 2, Paragraph 0031). Also, specifically regarding claim 70, Deschenes teaches a package of shims, which includes multiple sets of shims (3 or more as shown in figures 8 and 9). It would have been obvious at the time the invention was made to a person having ordinary skill in the

art to modify the invention as taught by Rivin to have a plurality of shims of different thicknesses as taught by Deschenes, since Deschenes teaches that it is advantageous to have selectable thicknesses to provide an easier method of properly aligning shims.

2. Claims 61, 62, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Rivin (2003/0185624) in view of Deschenes (US Publication 2002/0148172) as applied to claims 59 and 65 above, and further in view of Ingold (US Patent 4,713,922).

Regarding claims 61 and 67, Rivin and Deschenes both teach the claimed method and invention with the exception of a method and apparatus comprising at least one fastener for each frame holder to interconnect the shims disposed between the frame and the frame holder either to each other and/or to the frame holder (The examiner would like to point out that the applicant has not positively claimed the frame and frame holder). Ingold teaches a frame mounting structure with at least one fastener for interconnecting sets of shims disposed between a door mounting unit (element 24 and Column 4, Lines 24-33 and Lines 52-63). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Rivin to replace the interconnection thereof with a fastener interconnection as taught by Ingold, since Ingold teaches that it is advantageous to provide expandable shim surfaces to allow for the adjustment needed to provide a secure connection.

Regarding claims 62 and 68, Rivin and Deschenes both teach the claimed method and invention with the exception of a mechanism for holding the frame in the frame holder and the same mechanism will hold the frame and one or more shims in the frame holder below the frame and between the frame holder and the frame. (The examiner would like to point out that the applicant has not positively claimed the frame and frame holder). Ingold teaches a frame mounting structure wherein each frame structure includes a studding mechanism for interconnecting (7) for the one or more shims (12,14) in the mounting connection (Column 5, Lines 53-68 and Column 6, Lines 1-6). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Rivin to include a mechanism for holding the frame and the shims as taught by Ingold, since Ingold teaches that it is advantageous to provide a secure and permanent connection thereby preventing movement of the frame and shims.

### ***Allowable Subject Matter***

3. Claims 51,52 and 71-80 are allowed
4. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 51, the prior art does not teach or render obvious a method for modifying an existing printing press to accept a pair of height-adjusting shims comprising the steps of: positioning each one of the pair of shims on each of a pair of opposed frame holders, determining at least one location for an aperture on each of the opposed frame holders to facilitate fastening of the pair of shims to the pair of opposed

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frame holders, positioning a drill bit on each of the opposed frame holders at the determined location and drilling a hole in each of the opposed frame holders at the determined location.

Regarding claims 71 and 76, the prior art does not teach or render obvious a method for adjusting the vertical height of a frame for a screen supported by one or more frame holders relative to an item to be printed upon comprising the step of positioning the selected at least one set of shims simultaneously between a frame holder and the frame to adjust and evenly increase the vertical distance between the frame and the item to be printed upon.

### ***Response to Arguments***

5. Applicant's arguments filed 12/12/05 have been fully considered but they are not persuasive. Regarding applicant's comments on page 7, 1<sup>st</sup> paragraph, the examiner notes that Rivin may discuss the use of shims for reducing friction, however a shim is simply a piece of material such as wood, metal, etc. that is used to adjust something to fit properly as seen below. In the broadest interpretation, Rivin teaches the feature of a set of generally uniformed shims as disclosed in claims 59 and 65.

#### **shim**

*n.*

A thin, often tapered piece of material, such as wood, stone, or metal, used to fill gaps, make something level, or adjust something to fit properly.

#### ***tr.v.* shimmed, shim·ming, shims**

To fill in, level, or adjust by using shims or a shim.

---

[Origin unknown.]

shim

n : a thin wedge of material (wood or metal or stone) for driving into crevices

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6. With respect to applicant's comments, "They act as spacers to increase the physical distance between the item to be printed upon and the frame holding the screen", the examiner understands the invention claimed, however the recitation "screen" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, with respect to comments on page 9, 1<sup>st</sup> paragraph, the examiner again would like to note that applicant's invention may be a screen printing machine, however the screen printing machine is not positively claimed within the claims.

7. In response to applicant's comments, "Deschenes discloses simple and double-width shims that are "wedge-shaped" or "tapered". This is the antithesis of Applicant's invention which requires spacers of uniform thickness", again as disclosed above a definition of a shim can be interpreted as a tapered piece of material as discussed on



page 7 of the office action. Also, the examiner relied on the Rivin reference for uniform thickness as disclosed in Rivin (Page 2, Paragraph 0024, Lines 13-15).

8. With respect to applicant's comments on the Ingold reference, the examiner was simply using the reference for the teachings of a nail as a form of interconnecting purposes.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson-Samreth whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone

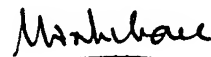
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson-Samreth  
Examiner  
Art Unit 2854

MFS



MINH CHAU  
PRIMARY EXAMINER